



25 MAY 2005
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

VENABLE LLP
PO Box 34385
Washington, DC 20043-9998

In re Application of: BROGARDH, Torgny, et al.	:	
U.S. Application No.: 10/501,554	:	DECISION ON PETITION TO
PCT No.: PCT/SE02/00075	:	CORRECT INVENTORSHIP
International Filing Date: 16 January 2002	:	
Priority Date: None	:	
Attorney's Docket No.: 43315-205197	:	
For: INDUSTRIAL ROBOT	:	

This decision is issued in response to the "Request To Correct Inventorship" filed 05 May 2005, treated herein under 37 CFR 1.497(d). Applicants have paid the required processing fee.

BACKGROUND

On 16 January 2002, applicants filed international application PCT/SE02/00075 which did not claim an earlier priority date and which designated the United States. On 24 July 2003, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB"). The published international application identified four applicant/inventors for the United States: Torgny BROGARDH, Daniel WAPPLING, Asa VALLIN, Mathilda ANDREASSON, and Ivan LUNDBERG.

The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 16 July 2004.

On 16 July 2004, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 11 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration in compliance with 37 CFR 1.497 was required.

On 05 May 2005, applicants filed a response to the Notification Of Missing Requirements that included a declaration document and the "Request To Correct Inventorship" considered herein. The request seeks to remove inventor Daniel WAPPLING from the application and add inventor Hans SKUTBERG.

DISCUSSION

The declaration document filed by applicants on 05 May 2005 identifies and is executed by five inventors: Hans SKUTBERG, Torgny BROGARDH, Asa VALLIN, Mathilda

ANDREASSON, and Ivan LUNDBERG. This does not correspond to the inventorship listed on the international application. Specifically, the declaration adds Hans SKUTBERG as an inventor and removes Daniel WAPPLING. As noted above, the present submission seeks to correct the inventorship to correspond to the filed declaration.

Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).

Applicants' 05 May 2005 submission satisfies requirements (1) and (2), above, but item (3) is not satisfied. Specifically, while applicants have submitted a statement of consent from the purported assignee ABB AB, a copy of the assignment itself is not present in the application file. Either a copy of the assignment or a specific reference to its recorded location in the USPTO (i.e., reel and frame number) is required before the consent of the assignee can be accepted herein (see 37 CFR 3.73(b)). Because applicants have not satisfied all the requirements of 37 CFR 1.497(d), the inventorship herein cannot be corrected on the present record.

In addition, the declaration document filed 05 May 2005 is unacceptable in that it was submitted in an improper form. The six pages of declaration appear to be a compilation of more than one copy of the declaration (there are five copies of page "2 of 2" included in the document). Such compilation is impermissible (see M.P.E.P. § 201.03: "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration"). Accordingly, applicants must submit copies of the complete declarations executed by each of the inventors.

CONCLUSION

Applicants' request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The inventors of record remain the inventors named on the international application.

The declaration filed by applicants on 05 May 2005 is not acceptable under 37 CFR 1.497 in that the declaration appears to be an improper compilation of multiple declarations and it fails to properly identify the current inventors of record herein.

If reconsideration on the merits of this request under 37 CFR 1.497(d) is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and should include the materials required to satisfy 37 CFR 1.497(d)(3) (i.e., a copy of the assignment or a proper reference to the recorded assignment pursuant to 37 CFR 3.73(b)) and complete copies of each declaration executed by the inventors, as discussed above.

No additional petition fee is required. Failure to file a timely response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross
PCT Petitions Attorney
Office Of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459